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10/827,450	04/20/2004	Nicolette Theresa Hunter		2982

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10/06/2005

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EXAMINER

RODRIGUEZ, RUTH C

ART UNIT

PAPER NUMBER

3677

DATE MAILED: 10/06/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/827,450

Applicant(s)

HUNTER, NICOLETTE THERESA

Examiner

Ruth C. Rodriguez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Drawings

1. The drawings are objected to because: The brief description of the drawings recites that the drawings contain two figures 1A and 1B where 1A is a "Top diagram on the drawing" and 1B is a "Bottom diagram on the drawing". The replacement drawings received on 27 September 2004 are only identified as 1A and the drawing 1B is not identified. Additionally, the drawings appear to be top views of the invention and not a top diagram and a bottom diagram as recited in the brief description of the drawings. Finally, upper drawing appears to be a first embodiment of the invention while the lower drawing appears to be a different embodiment of the invention as identified by the descriptions provided in the drawings and in the brief description of the drawings. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the

remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

2. The spacing of the lines of the specification is such as to make reading difficult. New application papers with lines 1½ or double spaced on good quality paper are required.

Claim Objections

3. Claims 1 and 2 are objected to because of the following informalities:
 - Lines 2-7 of the first page of claims recites "What I claim as my invention is a system which uses a chain consisting of two halves. Each half is made up of graduated links. Each half has both a large finding on one end and a small finding on the other end. These findings fit into each other, and the findings of a bracelet or necklace, so that the wearer can close and wear a piece of jewelry which does not fit over his head or his wrist." It is unclear whether this statement is a claim or not. If it is a

claim, it should be numbered, otherwise "What I claim as my invention is:" should be kept and the rest of the statement should be deleted.

- For claim 1 and 2, each claim begins with a capital letter and ends with a period. Periods may not be used elsewhere in the claims except for abbreviations. The format of the claim should be corrected.

- Lines 1-4 of claim 1 should be deleted since these lines are not providing any structural limitations to the claim.

- Claim 1, line 5, "I claim as the" should be replaced with "A", the comma after extender should be deleted and "comprising" should be inserted between "extender," and "the".

- Claim 1, line 6, "two halves" should be replaced with --a left half and a right half--.

- Claim 1, lines 5-8, the chain is either claimed as being 1" in length or having variable length. Both alternatives can not be claimed. For purpose of examination, the chain can be considered as having any size since Applicant fails to provide any criticality for the length.

- Claim 1, line 10, "(i.e. small lobster or spring ring)" should be deleted. The use of parenthesis is only applied to recite reference characters of the drawings. Terms within the parenthesis make the claim indefinite because it is unclear if the terms within the parenthesis are meant to be part of the claim or not.

- Claim 1, line 11, "consists" should be replaced with --comprises-- otherwise the extender only can be two gradual links and additional links can not be claimed.
- Claim 1, between lines 12 and 13, "(ie. lobster or spring ring)" should be deleted.
- Claim 1 recites the limitation "the left half" in line 9, "the small O ring" in line 10 and "The right half" in line 13. There is insufficient antecedent basis for this limitation in the claim.
- Claim 2, lines 1-4 should be deleted since these lines are not providing any structural limitations to the claim.
- Claim 2, line 5, "to pass over the wearer's head. I claim as the" should be replaced with --A--, the comma after extender should be deleted and --comprising-- should be inserted after "extender,"
- Claim 2, line 6, "two halves" should be replaced with --a left half and a right half--.
- Claim 2, lines 6-9, the chain is either claimed as being 1" in length or having variable length. Both alternatives can not be claimed. For purpose of examination, the chain can be considered as having any size since Applicant fails to provide any criticality for the length.
- Claim 2, line 11, "(i.e. small lobster or spring ring)" should be deleted.

- Claim 2, line 13, "consists" should be replaced with --comprises-- otherwise the extender only can be two gradual links and additional links can not be claimed.
- Claim 2, line 14, "(ie. lobster or spring ring)" should be deleted.
- Claim 2 recites the limitation 'the left half' in line 10, "the small O ring" between lines 11 and 12 and "The right half" in line 14. There is insufficient antecedent basis for this limitation in the claim.

Correction is required.

Note that in dealing with claims, current practice in referring to line numbers is that line numbers refer to the number of the line of the claim and not the number of the line on the page *

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claim 2 is rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Flaherty (US 2004/00070174 A1).

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For claim 2, Flaherty discloses a necklace extender comprising the use of a chain consisting of a left half and a right half made of graduating links. The left half of the necklace extender has a small finding (4) at its left end, two or more gradually larger links (between 4 and the end of 1a) and a large finding at its other end (1a). The small finding fits into a small O ring (6,8) of a necklace (5,7). The right half of the necklace extender has a large O ring (1b) at its left end, several links that are gradually smaller (between 1b and 4) and a small O ring (4) at its other right end. The large O ring connects with the large finding of the left side (Figs. 1 and 3). The small O ring connects with the end (6,8) of a necklace. The necklace extender is connected to each other and by different sized finals to the necklace. The necklace extender makes the necklace easier to close and to wear (Figs. 1 and 3). The clasp located at the right end of the right half of the extender can be considered as the O-ring (forms a O-ring when it is closed) since the claim fails to disclose any details for the O-ring at the right end of the right half and it fails to provide any details of the end of the necklace being connected to the extender. However even if such details were provide, it would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a O-ring at the right end of the right half because the reversal of components in a prior art reference, where there is no disclosed significance to such reversal, is a design consideration within the skill of the art. In re Gazda, 219 F.2d 449, 104 USPQ 400 (CCPA 1955); In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950). In this case, such a reversal will be advantageous when connecting the extender to necklaces

having an O ring at one end and a finding at the other end instead of the necklaces being disclosed by Flaherty where the two ends have O rings.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Flaherty (US 2004/00070174 A1).

Flaherty discloses a necklace extender having all the features being recited above in paragraph 5 for the rejection of claim 2. Flaherty fails to disclose that the extender could also be worn in a bracelet as recited in claim 1. However, it would have been obvious to one having ordinary skill in the art at the time of Applicant's invention to have the extender being used with a bracelet instead of being used with a necklace since it is well known in the jewelry art to use the structure of a necklace for a bracelet and viceversa. Especially since the main differences between both pieces of jewelry is their length and the location where they are being worn and none of these factors affect the functionality of the system disclosed by Flaherty for a bracelet.

Manner of Response to the Office Action

35 U.S.C § 1.33 discloses that a shortened statutory period for response to an Office Action is set to expire three months from the date of the Office Action. Failure to respond within the period for response will cause the application to become abandoned. Therefore, Applicant must respond to *all* grounds of objection and rejection within three months. That response must include a response to *each* objection and rejection.

A proper response to an Office Action should include:

Instructions to cancel or amend the rejected claims or to substitute, or to add claims to be considered by this Office (see the Manner of Making Amendments below for instructions on how to amend an application);

Acknowledgement of objections to the drawing and/or specification by:

Specific instructions to correct these defects, or

Requesting that these objections be held in abeyance until allowable subject is indicated.

Applicant should further submit an argument under the heading "Remarks" in which the applicant points out where the applicant disagrees with the examiner's contentions and wherein the applicant also discusses the references applied against the claims, explaining how the claims avoid these references or how they distinguish from them in a patentable sense.

Note that while an application can be amended to make it clearly understandable, no subject matter can be added that was not disclosed in the application as originally filed.

37 CFR § 1.121 Manner of Making Amendments

Amendments to the Specification

Amendments to the specification are made, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made to the immediate prior version. An accompanying clean version is not required to show and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is submitted to incorporate extensive amendments, both a clean version (which will be entered) and a markup version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specifications must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions (1) for deletion of five characters or fewer double brackets may be used (e.g. [[error]]; and (2) if strikethrough cannot be easily perceived (e.g. deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g. [[4]]). As an alternative to double brackets, however, extra portions of text

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may be included before and after being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change.

Amendments to the Claims

Amendments to a claim must be made by rewriting the entire claim with all changes (e.g., additions and deletions) as indicated in this subsection, except when the claim is being canceled. Each amendment document that includes a change to an existing claim, cancellation of an existing claim or addition of a new claim, must include a complete listing of all claims ever presented, including the text of all pending and withdrawn claims, in the application. The claim listing, including the text of the claims, in the amendment document will serve to replace all prior versions of the claims, in the application. In the claim listing, the status of every claim must be indicated after its claim number by using one of the following identifiers in a parenthetical expression: (Original), (Currently amended), (Canceled), (Withdrawn), (Previously presented), (New), and (Not entered).

(1) *Claim listing.* All of the claims presented in a claim listing shall be presented in ascending numerical order. Consecutive claims having the same status of "canceled" or "not entered" may be aggregated into one statement (e.g., Claims 1–5 (canceled)). The claim listing shall commence on a separate sheet of the amendment document and the sheet(s) that contain the text of any part of the claims shall not contain any other part of the amendment.

(2) *When claim text with markings is required.* All claims being currently amended in an amendment paper shall be presented in the claim listing, indicate a

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status of “currently amended,” and be submitted with markings to indicate the changes that have been made relative to the immediate prior version of the claims. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters. The text of any deleted subject matter must be shown by being placed within double brackets if strike-through cannot be easily perceived. Only claims having the status of “currently amended,” or “withdrawn” if also being amended, shall include markings. If a withdrawn claim is currently amended, its status in the claim listing may be identified as “withdrawn—currently amended.”

(3) *When claim text in clean version is required.* The text of all pending claims not being currently amended shall be presented in the claim listing in clean version, *i.e.*, without any markings in the presentation of text. The presentation of a clean version of any claim having the status of “original,” “withdrawn” or “previously presented” will constitute an assertion that it has not been changed relative to the immediate prior version, except to omit markings that may have been present in the immediate prior version of the claims of the status of “withdrawn” or “previously presented.” Any claim added by amendment must be indicated with the status of “new” and presented in clean version, *i.e.*, without any underlining.

(4) *When claim text shall not be presented; canceling a claim.*

(i) No claim text shall be presented for any claim in the claim listing with the status of “canceled” or “not entered.”

(ii) Cancellation of a claim shall be effected by an instruction to cancel a particular claim number. Identifying the status of a claim in the claim listing as "canceled" will constitute an instruction to cancel the claim.

(5) *Reinstatement of previously canceled claim.* A claim which was previously canceled may be reinstated only by adding the claim as a "new" claim with a new claim number.

Amendments to the Drawings

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with CFR 14.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations. Any replacement drawings sheet must be identified in the to margin as "Replacement Sheet" and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g. as an appendix). The figure or figure number of the amended drawing(s) must not be labeled as "amended". If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Extension of Time Practice

37 CFR § 1.136(a) permits an applicant to file a petition for extension of time and a fee as in 37 CFR § 1.17(a), (b), (c), or (d) up to three months after the end of the time period set to take action except (1) where prohibited by statute, (2) in interference proceedings, or (3) where applicant has been notified otherwise in an Office Action. The petition and fee must be filed within the extended time period for response requested in the petition and can be filed prior to or with the response. The filing of the petition and fee will extend the time period to take action up to three months dependent on the amount of the fee paid except in those circumstances noted above. 37 CFR § 1.136(a) will effectively reduce the amount of paperwork required by the applicants and the Office since the extension will be effective upon filing of the petition and payment of the appropriate fee and without acknowledgement or action by the Office and since the petition and fee can be filed with the response.

The statute at 35 U.S.C. § 41(a)(8) requires the filing of a petition to extend the time and the appropriate fee. Such a petition need not be in any required format. A proper petition may be a mere sentence such as

The applicant herewith petitions the Commissioner of Patents and Trademarks to extend the time for response to the Office Action dated ___ for ___ month(s); to cover the cost of the extension, please charge my deposit account number ___ in the amount of _____. Any deficiency or overpayment should be charged or credited to the above numbered deposit account.

The charges set forth for small entity time extensions are as follows:

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Extension for response within first month	-	\$ 55.00
Extension for response within second month	-	\$210.00
Extension for response within third month	-	\$475.00

Certificate of Mailing Practice

It is called to applicant's attention that if a communication is mailed before the response time has expired applicant may submit the response with a "Certificate of Mailing" in accordance with 37 CFR § 1.8(a) which merely asserts that the response is being mailed on a given date. So mailed, before the period for response has lapsed, the response is considered timely. The following is a suggested format for the certificate of mailing under 37 CFR § 1.8(c) that should be included with all correspondence.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner of Patents and Trademarks, Washington, D.C. 20231, on _____

Name of applicant, assignee, or Registered Representative

Signature _____

Date _____

37 CFR § 1.8 and the suggested form for patent cases established a practice before the Patent and Trademark Office which is referred to as the "Certificate of Mailing Procedure." Under this procedure, a person may state on certain papers

directed to the Office (exceptions are stated in 37 CFR § 1.8), the date on which the paper will be deposited in the United States Postal Service. If the date of deposit is within the period for response, the response in most instances will be considered to be timely. This is true even if the paper does not actually reach the Office until after the end of the period for response. The Certificate of Mailing procedure does not apply to papers mailed in a foreign country.

It should be noted, however, that the Office will continue its normal practice of stamping the date of receipt (Mail Room Stamp) on all papers received through the mails except those filed under 37 CFR §1.10. The date stamped will also be the date which is entered on Office records and from which any subsequent periods are calculated. For example, 37 CFR § 1.192 gives appellant 2 months from the date of the appeal to file an appeal brief. For example, if the last day to respond to a final rejection was November 10, 1976, and applicant deposited a Notice of Appeal with fee in the U.S. Mail on November 10, 1976 and so certified, that appeal is timely even if it was not received in the Patent and Trademark Office until November 17, 1976. Since the date of receipt will be used to calculate the time at which the brief is due, the brief was due on January 17, 1977. This is 2 months after the Mail Room date.

It would be of great assistance to the Office if all incoming papers pertaining to a filed application carried the following items:

Serial number (checked for accuracy).

Group art unit number (copied from filing receipt or most recent Office Action).

Filing date.

Name of the examiner who prepared the most recent Office action.

Title of invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Johnson et al. (US 3,733,852), Flaherty (US 2004/0007017 A1) and Emberson et al. (US 2004/0200236 A1) are cited to show state of the art with respect to the use of extender in chains.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ruth C Rodriguez whose telephone number is (571) 272-7070. The examiner can normally be reached on M-F 07:15 - 15:45.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, J. J. Swann can be reached on (571) 272-7075.

Submissions of your responses by facsimile transmission are encouraged. The fax phone number for the organization where this application or proceeding is assigned

Responses submitted by facsimile transmission should include a Certificate of Transmission (MPEP § 512). The following is an example of the format the certification might take:

(Signature)

If your response is submitted by facsimile transmission, you are hereby reminded that the original should be retained as evidence of authenticity (37 CFR 1.4 and MPEP § 502.02). Please do not separately mail the original or another copy unless required by the Patent and Trademark Office. Submission of the original response or a follow-up

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copy of the response has been transmitted by facsimile will cause further unnecessary delays in the processing of your application, duplicate responses where fees are charged to a deposit account may result in those fees being charged twice.


Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-6640.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ruth C. Rodriguez
Patent Examiner
Art Unit 3677

RJR
rcr

October 1, 2005


ROBERT J. SANDY
PRIMARY EXAMINER